

REMARKS

By the Final Office Action of 1 August 2000, Paper No. 8, Claims 1-9 are pending in the application, and all currently rejected by the Examiner. By the present Response and Amendment, Claims 1 and 3-9 are amended. No new matter is believed introduced by the present Response and Amendment. The Applicant respectfully submits that the following amendments place the Application in condition for allowance and/or place the Application in better form for appeal. Thus, Applicant requests the amendments be entered.

If the Examiner accepts the amended Claims, Applicant respectfully requests that the newly presented Claims 10-13 be entered as well.

1. The Claims

Independent Claim 1 is amended to clarify what is claimed, and to further distinguish the claimed invention from the cited prior art. The game call of the present invention is a one-piece device as to the game call and elevating device which is believed novel and non-obvious as further described below.

Independent Claim 1 further is amended to recite a sound emanating surface having apertures through which the sounds escape the game call, as particularly distinguished from Bowes, which has no equivalent structure. The Bowes device produces sounds through a funnel-shaped speaker assembly.

Additionally, Claim 1 is amended to recite that the elevating device raising the sound emanating surface from the user's body provides an unencumbered path for the sounds to escape the game call and reach ambient. The Bowes device incorporates an unrelated skirt 44 that touches the user's body, and the skirt fully encircles the area of contact. The present invention comprises legs, for example, such that sounds exiting the game call between the call and the user's limb can reach ambient without being significantly muffled or trapped between the call and the limb, as is the case with the Bowes call.

As independent Claim 10 similarly claims such a game call, it is believed that new Claims 10-13 are novel and non-obvious.

2. The Present Invention Is Distinguishable From The '091 Patent

The Examiner maintains the rejection of Claims 1-9 in view of U.S. Patent No. 5,607,091 to Musacchia ("the '091 patent"). The Examiner realleges that the unitary game call of the present invention is obvious in view of the '091 patent "since this would aid in the portability and usage of the device." *Office Action*, p. 6. The Examiner notes that the Applicant's arguments of 2 February 2000 were fully considered, but that the "drawings [of the '091 patent] clearly would lead to one of ordinary skill in the art to modify the separate game call portion and the holder of the Musacchia to make it unitary for the purpose of reducing manufacturing costs." *Id.*

The Applicant respectfully submits that the Examiner improperly focuses on the *differences* between the '091 device and the present one-piece call, and concludes that the present invention is obvious. Yet, the pending application argues at length, and recites in detail, numerous non-obvious improvements that the present device incorporates over the prior art, and these differences are both *structural and functional*. The present one-piece call and elevating device provides a superior sound and reduces the problems of lost calls in the field. The are advantages over the prior art *over and above just that the present invention is less costly to manufacture* as focused upon by the Examiner.

In determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the differences themselves would have been obvious, but whether the *claimed invention as a whole would have been obvious*. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). The *Schenck* case is particular insightful in view of the present situation. The claims were directed to a vibratory testing machine (a hard-bearing wheel balancer) comprising a holding structure, a base structure, and a supporting means which form "a *single integral and gaplessly continuous piece*." (emphasis added) It was argued that the invention was just making integral what had been made in four bolted pieces (as Applicant respectfully submits the Examiner alleges in the present case), but improperly limiting the focus to a structural difference from the prior art and failing to consider the invention as a whole. The prior art perceived a need for mechanisms to dampen resonance, whereas the inventor in *Schenck* eliminated the need for dampening via the *one-piece* gapless support structure. "Because that insight was contrary to the understandings and expectations of the art, the structure effectuating it

would not have been obvious to those skilled in the art." 713 F.2d at 785, 218 USPQ at 700 (citations omitted).

In *In re Hammond*, 124 F.2d 222, 52 USPQ 101 (CCPA 1941) a similar issue was raised. The invention disclosed in the application related to a one-piece-channel-shaped stop bar or rack for a typewriting machine. In rejecting the involved claims the primary examiner applied a general rule that there is no invention in forming a member in one piece instead of several pieces secured together, where no change in function or operation is involved. The Board of Appeals reversed:

Since detenting of the stops is a necessary function of a rack bar, it appears to us that the problem presented in making the rack bar of Kurowski in one piece presents something more than merely making in one piece that which had formerly been made in three pieces. We are of opinion that it would not be obvious to one skilled in the art to modify the Kurowski device so as to make a rack of one piece construction. *Id.*

Applicant respectfully submits that the present situation presents a factually similar case as to the above case law. It is not proper to simplify the present invention as making one-piece that which was two-pieces in order to reject the present invention as obvious. The Applicant shows that the application sets forth numerous factors rebutting this general rule such that a case of non-obvious has clearly been established.

It was not a mere engineering choice to alter the '091 device into the present invention. Mr. Musacchia, now deceased, is the inventor listed on the '091 patent, and is the father of the inventor of the instant device. Both men worked together for a number of years in the family business, now run by the present inventor and his sister, and, thus, Mr. Musacchia, Jr. is well aware of his customer's needs and complaints regarding game calls.

The '091 device is a game call *holder*, and not a game call like the present application. Upon production and sale of the game call *holder* of the '091 patent, the Musacchias received numerous inquiries and complaints regarding disadvantages of his '091 Holder. Several of the disadvantages of the '091 included:

1. Customers complained of lost game calls using the '091 holder. Game calls can cost upwards of \$80, and sometimes became dislodged from under the tie-down straps of the holder upon sudden movement. Thus, after the hunter got his shot off, and he began his run toward the game, the game call would fall to the ground. As everything related to the hunt was

camouflaged, including the call, it was rare for a dropped call to be found.

2. Customers also sought more realistic sound from their calls. As calls of several dimensions could fit on the '091 holder, depending on proper fit, the sound of the game used in connection with the holder was not always true.

3. Customers also questioned the costs associated with buying separate game calls and holders.

With these comments in mind, the inventor designed the present one-piece game call in an attempt to address these disadvantages (over just economic manufacturing), as is disclosed in the application:

In U.S. Patent No. 5,607,091 to Musacchia, is described a universal game call holder, which holder device comprised a platform to be used in conjunction with a separately purchased prior art call, wherein the call is retained in the platform by a retaining element. With the '091 holder, the conventional call slips within an aperture in the platform, which platform elevates the bottom of the call away from the user's limb.

The Musacchia device [of the '091 patent] discloses and claims only a game call platform having, among other things, a retaining element to maintain the hunter's call in contact with the platform. The present invention obviates the need for: 1) a separate platform; 2) a retaining element to secure the call to the holder; and 3) a separate call. The present call is a unitary call device, eliminating any construction by the user, and having no retaining element to use, repair or replace. Specification, p. 3, lines 3-13.

As further disclosed, the present invention provides numerous advantages over the prior art, including the '091 holder:

The present game call has a number of advantages over the above prior art. The unitary game call production costs are lower than the production costs associated with independently producing a game call and a holder. Therefore, the costs to the hunter for a game call that is elevated from the hunter's limb, while being attached thereto, will be less. Additionally, the prior art holder and aperture therethrough are of one design, while the sound emanating surface of the game call placed in the holder maybe an entirely different design. The present invention is manufactured as one piece. Therefore, the acoustics of the present invention are considerably better than the prior art acoustics. The sound emanating surface of the present invention is not hindered or impeded by a misshaped aperture for the specific game call used in the prior art. Specification, p. 4, lines 18-27.

In *Krementz v. S. Cottle Co.*, 148 U.S. 556 (1893), appellant sued to restrain alleged infringement of his patent for a new type of collar button. The lower court held that the patent was invalid for want of novelty and dismissed the suit. The Court granted certiorari and reversed. It held that appellant's invention represented a new and useful article with obvious advantages over previous structures of the kind, due to its being made from one continuous piece of metal rather than of two pieces soldered together.

The view of the court below, that Krementz's step in the art was one obvious to any skilled mechanic, is negated by the conduct of Cottle, the president of the defendant company. ... In his specification he speaks of the disadvantages of what he calls "the common practice to make the head, back and post of collar and sleeve buttons *separate, and to unite them by solder.*" His improvement was to form a button of two pieces, the post and base forming one piece, and then soldering to the post the head of the button as the other piece. Yet, skilled as he was, and with his attention specially turned to the subject, he failed to see, what Krementz afterwards saw, that a button might be made of *one continuous* sheet of metal, *wholly dispensing with solder*, of an improved shape, of increased strength, and requiring less material. *Id.* at 560-1 (emphasis added).

It is further argued, however, that supposing the devices to be sufficiently described, they do not show any invention; and that the combination set forth in the fifth claim is a mere aggregation of old devices already well known; and therefore it is not patentable. *This argument would be sound if the combination claimed by Webster was an obvious one for attaining the advantages proposed, -- one which would occur to any mechanic skilled in the art.* But it is plain from the evidence, and from the very fact that it was not sooner adopted and used, that it did not for years occur in this light to even the most skilful persons. It may have been under their very eyes; they may almost be said to have stumbled over it; but they certainly failed to see it, to estimate its value, and to bring it into notice. Who was the first to see it, to understand its value, to give it shape and form, to bring it into notice and urge its adoption, is a question to which we shall shortly give our attention. *At this point we are constrained to say that we cannot yield our assent to the argument, that the combination of the different parts or elements for attaining the object in view was so obvious as to merit no title to invention.* Now that it has succeeded, it may seem very plain to any one that he could have done it as well. This is often the case with inventions of the greatest merit. It may be laid down as a general rule, though perhaps not an invariable one, that if a new combination and arrangement of known elements produce a new and beneficial result never attained before, it is evidence of invention. It was certainly a new and useful result to make a loom produce fifty yards a day when it never before had produced more than forty; and we think that the combination of elements by which this was effected, even if those elements were separately known before, was invention sufficient to form the basis of a patent. *Id.*

(emphasis added).

To modify the '091 call holder as cited by the Examiner *contradicts* the very teachings of, suggestions in, and motivations behind the '091 call holder. The '091 holder is designed to work with *numerous* calls, and to provide *replacability* of calls and holders. The '091 teachings are contrary to the capabilities of the present invention (a one-piece construction to limit lost calls, to improve sound capabilities, to lower costs) neither taught nor suggested by the '091 call holder. These advantages of the present invention are clearly stated in the pending application. Applicant submits that the present game call as defined by the amended Claims is novel and non-obvious.

3. Claims Rejection Under 35 U.S.C. §112

Claims 1-9 stand rejected under 35 U.S.C. §112, first paragraph, as containing subject matter that was not described in the Specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner rejects the "unitary construction" language. Applicant amends Claim 1 to remove such language, and clarifies that the game call and elevating device are one-piece, and that the body attachment assembly is a second piece. This change has antecedent basis in the Specification and Drawings as originally filed and discussed in detail above.

Claims 1-9 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention, again related to the "unitary construction" language. It is believed this rejection is overcome by the amendments to Claim 1.

4. The Claims Rejection Under 35 U.S.C. §102

Claims 1-4, 6 and 7 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,716,254 to Bowes. In view of the amendments to Claim 1, Bowes neither teaches nor suggests:

- i. a sound emanating surface having apertures through which the sounds in the game call escape the game call;
- ii. an elevating device for elevating the sound emanating surface of the game call away from the user of the device; or

iii. an elevating device providing an unencumbered path for the sounds to escape the game call and reach ambient.

The Bowes device includes a striker plate 36 firmly attached to a users wrist or palm via a skirt 44 held snug against the user by a strap 50. Sound emanates from a funnel-shaped speaker 18 through which a striker end tip 20 extends.

As described above, the present invention is distinguished from Bowes as the sound emanating surface of the game call is raised above a users leg such that sound escaping the sound emanating surface through apertures therethrough is not stifled by the user's leg.

5. The Claims Rejection Under 35 U.S.C. §103

Claims 1-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,607,091 to Musacchia ("the '091 patent"). The Examiner alleges that the unitary game call of the present invention is obvious in view of the '091 patent "since this would aid in the portability and usage of the device." Office Action, p. 3.

Applicant submits that the present invention is non-obvious in view of the '091 reference, and respectfully requests reconsideration of this ground of rejection.

6. Fees

A two-month extension of time is submitted herewith, and, thus, a check in the amount of \$195.00 is enclosed.

CONCLUSION

By the present Response and Amendment, the Application has been in placed in full condition for allowance. Accordingly, Applicant respectfully requests early and favorable action. Should the Examiner have any further questions or reservations, the Examiner is invited to telephone the undersigned Attorney at 404.885.2773

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Box AF, Honorable, Commissioner for Patents, Washington, D.C. 20231 on 1/2/2001

Kimberly L. Weems

Name of Applicant Assignee, or

Registered Representative

Kimberly L. Weems

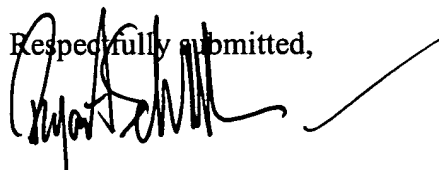
Signature

January 2, 2001

Date

TROUTMAN SANDERS LLP
Bank of America Plaza, Suite 5200
600 Peachtree Street, N.E.
Atlanta, Georgia 30308-2216
Tel: 404.885.2773
Fax: 404.962.6849

Respectfully submitted,



Ryan A. Schneider

Registration No. 45,083

The Commissioner is hereby authorized to charge any additional fees that are required, or credit any overpayment, to Deposit Account No. 20-1507.

C

APPENDIX A

1. A hunting device for producing sounds comprising:

(a) a one-piece game call and elevating device, wherein in the game call the sounds are produced, said game call having a scratch surface separated from a sound emanating surface, the sounds emanating surface having apertures through which the sounds in said game call escape the game call; and

(b) a body attachment assembly to releasably attach the game call and elevating device to the body of a user of the hunting device;

the elevating device elevating the sound emanating surface of said game call above the user of the device and providing an unencumbered path for the sounds to escape the game call and reach ambient.

3. A hunting device according to Claim 1, wherein said elevating device comprises legs each having a first end and a second end;

wherein said first ends of said legs are attached to said game call; and

wherein said second ends of said legs are in contact with the body limb by said body attachment device.

4. A hunting device according to Claim 1, wherein said elevating device comprises:

(a) a platform having a top surface and a bottom surface, said platform supporting said game call; and

(b) legs depending from said platform, each said leg having a first end and a second end, wherein said first end of each said leg is in contact with said platform; and

wherein said second end of each said leg is in contact with the body limb by said body attachment assembly.

5. A hunting device according to Claim 4, wherein said platform of the hunting device is substantially rectangular and includes front and rear legs extending from said bottom surface of said platform;

wherein said body attachment assembly is encirclable about a limb of a user's body to releasably secure the hunting device against a body limb of the user; and

wherein said platform and said legs elevate said sound emanating surface of said game call from the body limb.

6. A hunting device according to Claim 1, wherein said body attachment assembly is carried by said platform and comprises:

- (a) an elongated flexible element having one end connected to said platform;
- (b) an opposite free end on said flexible element provided with a hook; and
- (c) a receiving formation on said platform, wherein said hook is selectively engagable and disengagable relative said receiving formation.

7. A hunting device according to Claim 6, wherein said receiving formation includes a slot in said platform of the device.

8. A hunting device according to Claim 7, wherein said elongated flexible element comprises:

- (a) a strap; and
- (b) a buckle on said strap allowing for the adjustment of the length of said strap.

9. A hunting device according to Claim 6, further comprising:

- (a) a flexible tether having opposing ends; and
- (b) a striker;

wherein said opposing ends of said tether are respectively attached to said striker and said platform of the device.

10. A hunting device for a hunter, the hunting device for producing sounds and comprising:

- (a) a one-piece game call with legs, the game call having a scratch surface and a sound emanating surface, the sound emanating surface having apertures through which sound in the game call can escape the game call, each leg extending from the sound emanating surface and terminating in a leg end; and

- (b) a body attachment assembly to releasably secure each leg end to a hunter; the sound emanating surface being separated a distance from a hunter by the legs, each leg end in communication with the user, the legs providing an unencumbered path for the sounds to escape the game call and reach ambient.

11. The hunting device according to Claim 10, further comprising:

- (a) a flexible tether having opposing ends; and
- (b) a striker;

wherein said opposing ends of the tether are respectively attached to the striker and the game call.

12. The hunting device according to Claim 10, wherein the body attachment assembly comprises:

- (a) an elongated flexible element having one end connected to the game call;
- (b) an opposite free end on the flexible element provided with a hook; and
- (c) a receiving formation on the game call, wherein the hook is selectively engagable and disengagable relative the receiving formation.

13. The hunting device according to Claim 12, wherein the elongated flexible element comprises:

- (a) a strap; and
- (b) a buckle on said strap allowing for the adjustment of the length of said strap.